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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10014423 -1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert G. Gann et al

Confirmation No.: 2734

Application No.: 09/845391

Examiner:

Filing Date: Apr 30, 2001

Group Art Unit:

Title: Image Scanner Photosensor Assembly With Improved Spectral Accuracy And Increased Bit-Depth

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF REPLY BRIEFTransmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 1-12-2006

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,

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PATENT APPLICATION

ATTORNEY DOCKET NO. 10014423-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert G. Gann

Serial No.: 09/845,391

Examiner: Hannett, James M

Filing Date: 04/30/2001

Group Art Unit: 2612

Title: Image Scanner Photosensor Assembly With Improved Spectral Accuracy and Increased Bit-Depth

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

REPLY BRIEF

CLAIMS 1-4 AND 6

No *prima facie* case for obviousness has been established, because:

1. the examiner has not provided a teaching or motivation in the prior art to combine;
2. the examiner has not shown that a combination would result in the specific limitations of claim 1; and
3. the examiner has not provided motivation in the prior art to modify a combination to provide the limitations of claim 1.

In the Examiner's Answer, page 11, the examiner asserts that it would be obvious to one of ordinary skill in the art at the time of the invention was made to set the six lines of photo-sensors in Decker *et al.* to use six different bandwidths as taught in Nakamura *et al.* "to distinguish between photographic originals and color prints". The examiner's rationale is provided by Nakamura *et al.* alone, and the examiner has not provided any support in the prior art for adding the specific arrangement of Decker *et al.* to Nakamura *et*

al. to accomplish a result or advantage that is accomplished by Nakamura *et al.* alone. Nakamura *et al.* teach that using six spectral bandwidths along with a proper discriminant algorithm is useful for classifying the type of image being scanned. That is, the result or advantage stated by the examiner is accomplished in Nakamura *et al.* alone. Accordingly, the examiner's argument for a combination does not meet the requirements for a *prima facie* case for combining as specified in MPEP 2143 and 2144.

A combination of Decker *et al.* and Nakamura *et al.* teaches only the general structure of staggered line arrays and receiving six spectral bandwidths, but that general teaching does not teach or suggest the specific limitation of receiving a different spectral bandwidth by each line in a staggered array. At most, a combination of Decker *et al.* and Nakamura *et al.* teaches six sets of staggered arrays receiving six different spectral bandwidths. Decker *et al.* and Nakamura *et al.*, individually or in combination do not teach or suggest that a spectral bandwidth of light received by a first line of a staggered array may be different than the spectral bandwidth of light received by a second line of the staggered array. Accordingly, even if combined, a combination of Decker *et al.* and Nakamura *et al.* does not teach or suggest all the limitations of claim 1, as required by MPEP 2143.03.

In the Brief On Appeal, the applicant argued that a combination of Decker *et al.* and Nakamura *et al.* would render the prior art invention being modified unsatisfactory for its intended purpose. In the Examiner's Answer, pages 11 and 12, the examiner has not rebutted the assertion that a combination would render the prior art invention being modified unsatisfactory. Instead, the examiner merely argues that the technical reasons why modification would render the prior art unsatisfactory are not specified in the claims. The examiner's requirement is not applicable to the argument being made, and the examiner has cited no authority for such a requirement. The applicant is arguing why a combination of the prior art renders the prior art unsuitable for its intended purpose, and there is no requirement for those arguments or reasons to be specified in the claims. For example, in MPEP 2143.01.V, the argument regarding turning the reference device upside down is not something that was expressly claimed.

CLAIM 5

From MPEP 2143.01.III, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Claim 5 specifies photosensors having two different sizes receiving different spectral bandwidths. A combination of Decker *et al.*, Nakamura *et al.* and Kusaka *et al.* does not teach or suggest the specific limitations of claim 5. Accordingly, for a *prima facie* case for obviousness, the examiner must provide support in the prior art for modification. Kusaka *et al.* are concerned with autofocus, not color, and they do not teach or suggest anything about spectral bandwidths of light being received by the photosensors. Accordingly, there is no teaching or suggestion in the prior art to modify the combination. In the Examiner's Answer, pages 12 and 13, the examiner cites *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. and Inter. 1985), which is irrelevant to a discussion regarding modification. From MPEP 2145.II, *Ex parte Obiya* deals with an applicant recognizing previously unrecognized but inherent advantages. The present applicant is not arguing about the advantages or properties of the combination. The applicant is arguing whether the prior art teaches or suggests modification of the prior art.

In the Examiner's Answer, page 13, the examiner cites advantages regarding signal to noise that are taught in Kusaka *et al.*. The signal to noise advantages of different sizes are not relevant to different spectral bandwidths, and in particular are not relevant to having photosensors of different sizes receiving different spectral bandwidths.

CLAIMS 8 AND 9

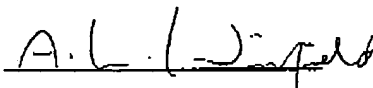
In the Brief on Appeal, at page 8, applicant asserted: "There is no teaching or suggestion in a combination of Decker *et al.*, Nakamura *et al.*, and Kuska *et al.* to combine information from two different sizes of pixels during one scan." In the Examiner's Answer, page 13, instead of providing additional argument, the examiner has merely re-cited Kusaka *et al.*, column 6, lines 8-50 for teaching that image data from both large and small pixels are synthesized together at the output. As discussed in the Brief on Appeal, the cited text does not support the examiner's assertion. As discussed in the Brief on Appeal,

the cited text states that the photodiodes dump charge to a common shift register, but it does not teach combining charges from two different sizes of pixels during one scan.

CONCLUSION

In view of the above, applicant respectfully requests that the examiner's rejection of claims 1-6 and 8-9 be reversed.

Respectfully submitted,



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February 28, 2006

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